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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,791	09/25/2003	Joseph G. Wilson	54820-00602	6407
25243 7590 10/18/2007 KELLEY DRYE & WARREN LLP 3050 K STREET, NW SUITE 400 WASHINGTON, DC 20007			EXAMINER BOVEJA, NAMRATA	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 10/18/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/669,791	WILSON, JOSEPH G.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Namrata Boveja	3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-23 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2006 and 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :09/24/07, 02/28/06, 07/14/05, 03/09/05, 05/05/04.

### **DETAILED ACTION**

1. This office action is in response to communication filed on 08/24/2007.
2. Examiner's notice to the Applicant for non-compliant amendment on 09/18/2007 has been vacated based on the Applicant initiated interview that took place on 10/09/2007. As agreed by the Applicant representative, David Youhanan, during the interview, Applicant withdraws claims in group 1, (claims 1-7) and newly added claim 24 that depends on claim 1. Applicant elected claims in group 2, (claims 8-23) and newly added claim 25 for examination with traverse.

### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, and 24 drawn to a method of delivering content to an audience member over a plurality of digital mediums based on an audience member profile, comprising providing access to first and second digital mediums, providing a common audience member profile to the mediums, associating audience member and delivering content to the audience member via the mediums, classified in class 709, subclass 224.
  - II. Claims 8-23, and 25 drawn to a method of delivering content to an audience member based on an audience member profile, comprising receiving a request for a website, storing a cookie associated with the website, identifying a unique identifier, storing and associating audience member with profile data and a segment of audience members, and

delivering content to the audience member, classified in class 709,  
subclass 219.

4. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as delivering content to an audience member over a plurality of digital mediums, which does not involve receiving a request for a website. See MPEP § 806.05(d).

Applicant's election with traverse of claims 1-25 in the reply filed on 08/24/2007 is acknowledged. The traversal is on the ground(s) that the new dependent claims 24 and 25 link the two groups of claims and do not pose a serious burden on the Examiner.

This is not found to be persuasive because the two independent claims are different in scope. For example, claim 1 starts out by providing access to first and second digital mediums and providing a common audience member profile to the mediums. On the other hand, claim 8 starts out by receiving a request for a website, storing a cookie associated with the website, and identifying a unique identifier. Therefore, the independent claims of group I are different in scope than the claims of group II, and they would require the Examiner to do another search. The newly added dependent linking claims do not contain the identical subject matter as the underlying independent, and therefore are insufficient in overcoming the original restriction requirement. The restriction requirement is still deemed proper, and is therefore made FINAL.

5. Claims 1-7 and 24 are withdrawn. Claims 8-23 and 25 are presented for examination.

**Claim Rejections - 35 USC § 112**

6. The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, since the recitation of delivering content to the audience member is indefinite. Specifically, it is unclear what is this content. The claim starts out by receiving a request for a first website page, so it is unclear if that first website page was ever delivered, since it is unclear if the content that is delivered refers to the first website page or to advertisements. It is interpreted to mean that the first website page is delivered along with advertising content. Appropriate correction is required.

7. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, since claim 11 depends on claim 8, and claim 8 recited storing a cookie associated with the first website page in a computer associated with the audience member and identifying a unique identifier for the audience member in the cookie. So, it is unclear how claim 11 recites providing a computer with a cookie....based on the initial absence of a unique identifier, since in claim 8, a unique identifier had been affirmatively identified. Therefore, anything that was recited in this claim limitation based on the absence of a unique identifier is not given any weight. The rest of the claim limitation following the absence of a unique identifier is also unclear. For example, the claim recites first

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website cookie and then recites first website page cookie. It is unclear if these two are the same thing or they are referring to something different. Furthermore, the claim recites providing a modified first website cookie, but it was never previously recited that the first website cookie was even modified. In light of the Applicant's specification, the claim is interpreted to mean that when a user requests a website, the user is redirected to a redirect page as provided by the advertiser, and the cookie associated with the user is updated based on the advertisement that is displayed to the user. Appropriate correction is required.

8. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, since it is unclear if the members who access the first and second mediums are the same or different and therefore their profiles are same or different. It is also unclear if the content that is delivered in claim 25, which depends on claim 8, is the same content that was delivered in claim 8. Furthermore, it is unclear if the content that is delivered in claim 25 to two different digital mediums is the same or different. Additionally, it is unclear similar to claim 8, if the content delivered at the end of the claim is the same as the first website page that was delivered at the beginning of the claim. It is interpreted to mean that identical content or supplemental content can be delivered to the same users via two different mediums. Appropriate correction is required.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:



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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 8-10 and 12-23, are rejected under 102(b) as being anticipated by the Merriman et al. (Patent Number 5,948,061 hereinafter Merriman).

**Disclaimer:** Claim 8 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 8, Merriman teaches a method of delivering content to an audience member based on an audience member profile, comprising the steps of: receiving a request for a first website page from the audience member (col. 3 lines 24-28); storing a cookie associated with the first website page in a computer associated with the audience member (i.e. a cookie is stored in the browser of the audience member's computer) (col. 3 lines 44-52); identifying a unique identifier for the audience member in the cookie (col. 3 lines 44-52 and 64 to col. 4 lines 11 and col. 5 lines 11-21); associating the audience member with profile data based on the unique identifier (col. 5 lines 11-21 and 50-63); associating the audience member with a segment of audience members based on the profile data (col. 5 lines 50-63 and col. 6 lines 6-11); and delivering content to the audience member based on the association of the audience member with the segment of audience members (col. 6 lines 6-11 and 27-59).

10. In reference to claim 9, Merriman teaches the method wherein the step of identifying a unique identifier in the cookie includes the steps of: determining the absence of a unique identifier for the audience member in the cookie, setting a unique identifier for the audience member in a second cookie, and storing the second cookie in



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the computer associated with audience member (i.e. it is inherent the second cookie is stored just like the first one, so that it can also be accessed in the database) (see at least col. 5 lines 19-30).

11. In reference to claim 10, Merriman teaches the method wherein the audience member is associated with a default segment of audience members as a result of storing the second cookie in the computer (i.e. audience member is shown a generic ad) (col. 5 lines 43-49).

12. In reference to claim 12, Merriman teaches the method further comprising the steps of: identifying the segment of audience members with a segment identifier included in a segment-targeting cookie (col. 5 lines 50-63); storing the segment-targeting cookie in the audience member computer (col. 3 lines 45-47 and col. 5 lines 22-29); and delivering content to the audience member based on the segment identifier (col. 5 lines 43-47 and col. 6 lines 6-11 and 54 59).

13. In reference to claim 13, Merriman teaches the method further comprising the steps of: collecting profile data relating to the audience member (col. 5 lines 47-49); and storing the profile data for the audience member in a database (col. 5 lines 50-63 and 63-65 and col. 7 lines 45 to col. 8 lines 30).

14. In reference to claim 15, Merriman teaches the method wherein the segment of audience members may be defined by rules that recognize any common affinity between two or more audience members (i.e. users who like computers) (col. 6 lines 3-11).

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15. In reference to claim 19, Merriman teaches a method of delivering content to an audience member based on profile data, comprising the steps of: storing audience member profile data in a database (col. 5 lines 50-63 and 63-65 and col. 7 lines 45 to col. 8 lines 30); associating the audience member with a segment of audience members based on the profile data (col. 5 lines 50-63 and col. 6 lines 6-11); identifying the segment of audience members with a segment identifier included in a segment-targeting cookie (col. 5 lines 50-63); storing the segment-targeting cookie on a computer associated with the audience member (col. 3 lines 45-47 and col. 5 lines 22-29); and delivering content to the audience member based on the segment identifier (col. 5 lines 43-47 and col. 6 lines 6-11 and 54 59).

16. In reference to claims 14 and 20, Merriman teaches the method wherein the step of collecting profile data includes collecting data from one or more sources selected from the group consisting of: a database, website page requests, advertisement requests (col. 6 lines 63 to col. 7 lines 12), user survey data (col. 5 lines 46-49), direct response data, and website search requests.

17. In reference to claims 16 and 23, Merriman teaches the method wherein the content is delivered to the audience member by a server selected from the group consisting of: an advertisement server (col. 5 lines 10 to col. 7 lines 44 and Figures 1 and 2), an email server, a streaming media server, and a website server.

18. In reference to claims 17 and 21, Merriman teaches the method wherein the step of associating the audience member with a segment of audience members further comprises the steps of: comparing the profile data of a plurality of audience members,

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and forming a segment of audience members based on the comparison of audience member profile data (i.e. if a user is one who like computers, sending him ads targeted to that segment) (col. 6 lines 3-11).

19. In reference to claims 18 and 22, Merriman teaches the method further comprising the steps of: periodically collecting additional profile data for the audience member (i.e. data regarding which ads the user has clicked on is obtained and surveys are also administered to the users) (col. 5 lines 50 to col. 6 lines 26, col. 6 lines 60-67, and col. 9 lines 39-46); and periodically determining which audience member segments the audience member is associated with, based on the profile data (col. 5 lines 50 to col. 6 lines 26, col. 6 lines 60-67, and col. 9 lines 39-46).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 11 is rejected under U.S.C. 103(a) as being unpatentable over Merriman in view of do Rosario Botelho et al. (Publication Number US 2002/0069105 hereinafter Rosario).

**Disclaimer:** Claim 11 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

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In reference to claim 11, Merriman does not teach the method wherein when a user requests a website, the user is redirected to a redirect page as provided by the advertiser, and the cookie associated with the user is updated based on the advertisement that is displayed to the user.

Rosario teaches the method wherein when a user requests a website, the user is redirected to a redirect page as provided by the advertiser, and the cookie associated with the user is updated based on the advertisement that is displayed to the user (page 3 paragraph 41 to page 4 paragraph 41, page 4 paragraph 48, page 5 paragraph 54, and Figure 6). It would have been obvious for Merriman to redirect users to a redirect page provided by the advertiser and to update the cookie associated with the user based on the advertisement that is displayed to allow advertisers to track which user clicked on their advertisements and to prevent showing the users the same advertisements they had already seen.

21. Claim 25 is rejected under U.S.C. 103(a) as being unpatentable over Merriman in view of Official Notice.

**Disclaimer:** Claim 25 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 25, Merriman teaches the method wherein the first website page is delivered over a first digital medium, where the audience member is associated with an audience member profile data, and associating the audience member with a segment of audience members (col. 3 lines 24-63 and col. 5 lines 9 to col. 6 lines 59).

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Merriman does not teach providing the audience member with access to a second digital medium, sharing profile data in common between the two mediums, associating the audience member with a segment of audience members based on the common profile data, and delivering the content over the second digital medium. Official Notice is taken that is old and well known to provide the audience member with access to a second digital medium, share profile data in common between the two mediums, associate the audience member with a segment of audience members based on the common profile data, and deliver the content over the second digital medium. For example, when supplemental content is being delivered to the same users with interactive television, the member can receive content based on his profile and segment data via the television and additional content can be received by the member on his computer via a website link. Additionally, a user may access his e-mail over his desktop computer which may select ads based on the user profile and segment data based on the cookies on his desktop computer that are stored at a central server, and may also send the same information to the user on his PDA based on the same set of underlying profile and segment data. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to provide the audience member with access to a second digital medium, share profile data in common between the two mediums, associate the audience member with a segment of audience members based on the common profile data, and deliver the content over the second digital medium to allow the user to receive targeted content on either medium over which he chooses to view the requested content.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Eric Stamber can be reached on 571-272-6724. The **Central Fax Number** for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

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October 10<sup>th</sup>, 2007

  
**RETTA YEHDEGA**  
**PRIMARY EXAMINER**